REMARKS

The claims have been amended according to the marked up amendments above. The amendments are supported by the claims, specification and drawings of the application as originally filed. No new matter is believed or intended to have been introduced by the amendments.

In the Office Action, claims 1 and 16-17 were rejected under 35 U.S.C. § 101 as supposedly directed to non-statutory subject matter. Additionally, claims 1-20 were rejected under 35 U.S.C. § 103 as supposedly obvious over the combination of U.S. published patent application 2002/0161676 ("Vadlamani") in view of U.S. patent 6,640,097 ("Corrigan"). However, as set forth below, each of the pending claims is clearly directed to statutory subject matter, and includes limitations which are not taught or suggested in either Vadlamani or Corrigan. Accordingly, the applicants request that the pending rejections under both sections 101 and 103 be reconsidered and withdrawn.

The Claims are Directed to Statutory Subject Matter

In the Office Action, the following explanation was given for the rejections of claims 1, 16 and 17 under 35 U.S.C. § 101:

> *Based on Supreme Court precedent and recent Corriganal [sic] Circuit decisions, a 35 U.S.C. §101 proecess must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottshalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).*
>
> *An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.*
>
> *Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.[1]*

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[1] Office Action at 2.

In response, and with respect to claim 1, the applicants have amended that claim to explicitly recite a step of "storing said descriptor file in a computer readable medium" and to recite that the handler from claim is 1 "resident on a computer comprising a processor operable to execute computer readable instructions." As a result, the applicants submit the concerns underlying the rejection of claim 1 based on 35 U.S.C. § 101 have been addressed, as claim 1 recites specific physical devices which are used in performing the recited steps.[2] Accordingly, the applicants request that the rejection of claim 1 under 35 U.S.C. § 101 should be reconsidered and withdrawn.

With respect to claims 16 and 17, the applicants note that the arguments presented in the Office Action cannot be used to justify rejecting those claims under 35 U.S.C. § 101 because the arguments from the Office Action are focused on whether a method satisfies 35 U.S.C. § 101, while claims 16 and 17 are directed to, respectively, a tangible computer readable medium and a system. A tangible computer readable medium such as recited in claim 16 clearly satisfies 35 U.S.C. § 101, because it is an article of manufacture.[3] Similarly, a system such as recited in claim 17 clearly satisfies 35 U.S.C. § 101 because it is a machine.[4] Accordingly, because the rejections of claims 16 and 17 under 35 U.S.C. § 101 are based on the incorrect assumption that those claims are directed to methods, the applicants request that those rejections be reconsidered and withdrawn.

The Claims Recite Limitations Which are Not Taught or Suggested in the Cited Art

Claim 1

Claim 1 is directed to a computerized method for billing for web services which recites the step of configuring a handler to send a pre-defined element designated in a descriptor file to a set of programmed instructions to create an event record. Claim 1 also

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[2] *See, e.g., Ex parte Wasynczuk,* appeal no. 2008-1496 (B.P.A.I. 2008) (holding method claim satisfied 35 U.S.C. § 101 based on its recitation of multiple devices used in performing that method).

[3] *See, e.g., Ex parte Holmstead,* Appeal 2009-1485 (B.P.A.I. 2009); *Ex Parte Bo Li,* Appeal 2008-1213 (B.P.A.I. 2008); *In re Beauregard,* 53 F.3d 1583 (Fed. Cir. 1995); *In re Lowry,* 32 F.3d 1579 (Fed. Cir. 1994).

[4] *See In re Nuijten,* 500 F.3d 1346 (Fed. Cir. 2007) (defining a "machine" as "a concrete thing, consisting of parts, or of certain devices and combination of devices").

recites that the set of programmed instructions is configured to copy the pre-defined element from a network communication monitored by the handler into the event record.[5]

Vadlamani, the primary reference cited against claim 1, clearly does not teach or suggest these limitations. Vadlamani discloses technology which is used to provide "prepaid fixed quantity access to web services."[6] Using the technology of Vadlamani, when a user wishes to access web services, he or she would contact a web server which includes a database for holding account information, and a time usage monitor for monitoring usage of internet services on a per-account basis.[7] Once the user has logged into the web server, the web server would provide the user with Internet services, and would also monitor the client's usage.[8] This monitoring involves, as long as the user is logged in, periodically decrementing the database's record of the time remaining for the account.[9] If there is no time remaining, the client is advised and services are terminated.[10] Otherwise, the services, and the associated monitoring, continue.[11]

This differs from claim 1 at least because Vadlamani does not operate by copying elements designated in a descriptor file from a network communication into an event record. Instead, Vadlamani monitors the time a user is logged on to a web server, and checks that time against an account value stored in a database. There is no teaching or suggestion anywhere in Vadlamani that the time is copied from a network communication into an event record. Further, the applicants note that Corrigan, the secondary reference cited against claim 1, cannot remedy the deficiencies of Vadlamani, as Corrigan was cited only for allegedly teaching transmitting the event record to a billing system for further processing,[12] and does not include any disclosure that teaches or suggests the limitations of claim 1 which

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[5] These limitations are found in the fourth clause after the preamble of claim 1, which recites:

> configuring said handler to send said pre-defined element to a set of programmed instructions to create an event record, wherein the set of programmed instructions is configured to copy the pre-defined element from the network communication into the event record.

The relationship between the pre-defined element and the descriptor file (i.e., that the descriptor file designates the pre-defined element) is specified by the first clause after the preamble of claim 1, which recites "creating a descriptor file designating a pre-defined element."

[6] Vadlamani, ¶ 6.
[7] *Id.* ¶¶ 40, 48.
[8] *Id.* ¶ 51.
[9] *Id.* ¶ 52.
[10] *Id.*
[11] *Id.*

are absent from Vadlamani. Accordingly, since a requirement for a prima facie case of obviousness is that all claim limitations must be taught or suggested in the cited art, the applicants request that the obviousness rejection of claim 1 be withdrawn, as a prima facie case of obviousness has not been, and cannot be, made out for that claim.

Claims 2-15

The applicants note that claims 2-15 each depend from claim 1, and therefore cannot be rejected as obvious over the combination of Vadlamani and Corrigan for at least the reasons given above for that claim.[13] Additionally, the applicants note that claims 2-15 each include further limitations which provide independent grounds for distinguishing those claims from the cited art. In particular, as set forth below, claims 2-4 include limitations which are clearly absent from the art cited in the Office Action. Accordingly, even if the rejection of claim 1 is maintained, the rejections of at least those claims should be withdrawn based on the unique limitations that they recite.

Turning first to claims 2 and 3, those claims limit claim 1 by reciting that the programmed instructions from claim 1 are configured to determine whether an event corresponding to the event record requires (respectively) authorization or rating. This is very different from Vadlamani, because, in that reference, there is no situation where a determination would be made whether an event requires authorization or rating.

Instead, in Vadlamani, the only determinations that are made are 1) whether a user has a valid account; 2) whether a user can authenticate his or her identity (e.g., with a password); and 3) whether there is value in the account which is available for the user. There is no indication anywhere in Vadlamani that (presuming a user has a valid account, can authenticate his or her identity, and has a positive available balance) there are some events which might require authenticating (or rating) and others that might not.

Accordingly, because claims 2 and 3 require that the programmed instructions are configured to "determine whether an event corresponding to the event record require" authorization (claim 2) or rating (claim 3), the applicants submit that the rejections of those claims should be reconsidered and withdrawn.

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[12] Office Action at 3.

Claim 4 limits claim 1 by reciting the additional step of transforming the pre-defined element which is copied into the event record before sending the event record to the billing system. Claim 4 also recites that the transforming is performed according to a set of instructions in the descriptor file. In the rejection of claim 4, the Office Action asserted that those limitations are taught in paragraphs 3-4, 12, 40 and 50-51 of Vadlamani, as well as in claim 31 of that same reference. However, upon review, it appears that none of those sections is even relevant to the limitations of claim 4. Claim 31 of Vadlamani recites a method where a user is provided with a prepaid web services account, and is able to authorize that account from multiple login sites. Paragraphs 3-4 of Vadlamani disclose prior art billing schemes used by ISPs, including unlimited flat fee use, and fee for service use. Paragraph 12 of Vadlamani discloses that the invention of Vadlamani includes a web service provider and that users are allocated prepaid fixed accounts which are monitored and debited based on usage. Paragraph 40 of Vadlamani provides a description of a server a user might log into, and specifies that it contains a database of user accounts and a time usage monitor. Paragraphs 50-51 of Vadlamani describe the process of logging into a web server. None of those passages includes any *hint* of transforming a pre-defined element which is copied into an event record prior to transmitting that event record to a billing system. Accordingly, the applicants submit that the limitations of claim 4 are also clearly absent from the cited art, and provide an independent basis for withdrawing the rejection of that claim.

Claims 16-17

In the Office Action, claims 16 and 17 were rejected as supposedly obvious over the same art which was cited in the rejection of claim 1.[14] However, as set forth above regarding claim 1, that art clearly does not teach or suggest copying pre-defined elements from a network communication into a record, limitations which are found in claims 16 and 17, as well as in claim 1. Accordingly, while claims 16 and 17 are obviously not identical to claim 1, the applicants submit that the arguments set forth above regarding monitoring a web service network communication apply to claims 16 and 17 as well, and therefore request that the rejections of claims 16 and 17 be reconsidered and withdrawn based on those arguments.

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[13] MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).").

Claims 18-20

In the Office Action, claims 18-20, like claims 16 and 17, were each rejected as obvious over the combination of Vadlamani and Corrigan. However, as set forth above, claims 16 and 17 include limitations which are not taught or suggested in those references. As a result, because claim 18 depends from claim 17, and because claims 19-20 depend from claim 16, the applicants submit that the rejections of claims 18-20 should be reconsidered and withdrawn for at least the reasons given above with respect to claims 16 and 17.

CONCLUSION

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. §§ 101 and 103. Accordingly, reconsideration and allowance of these claims are earnestly solicited. Further, the applicants submit that the above discussion does not constitute an exhaustive list of novel limitations or reasons why the pending claims should be allowed. To the extent that applicants have not addressed certain aspects of the present rejection, or seem to have adopted certain aspects of the present rejection in the arguments made herein, please do not construe the same as an admission as to the merits of the rejections.

If questions persist or additional matters need to be dealt with prior to allowance, the applicants encourage the Examiner to contact their representative, William Morriss, at (513)651-6915, or wmorriss@fbtlaw.com.

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[14] The rejections of claims 16-17 are on pages 6-7 of the Office Action.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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